

DETAILED ACTION

Supplemental Amendment

1. Applicant filed a supplemental amendment on 6 April 2010. The Office may enter a supplemental amendment only if it is "clearly limited to" one or more of six criteria (A)-(F) given in 37 CFR § 1.111(a)(2). As applicant noted in the remarks, the supplemental amendment meets this requirement by canceling claims. However, the examiner chooses not to enter the supplemental amendment, first because the examiner discovered it on 10 April 2010, after having largely written this present Office action. Second, the amendment does not simplify the claims for purposes of appeal: Applicant has canceled only four of 66 claims and incorporated their limitations into the parent claims.
2. Lastly, the supplemental amendment does not put the application in condition for allowance. However, the supplemental amendment does appear to be a good faith attempt to make the claims allowable, so it is discussed below. The rejection made herein is based on the claims as filed 22 December 2009.

Claim Interpretation

3. Unless a term is given an "explicit" and "clear" definition in the specification (MPEP § 2106.II.C), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification as it would be interpreted by one of ordinary skill in the art (MPEP § 2111). This means that the words of a claim must be given their "plain meaning" unless the plain meaning is inconsistent with the specification (MPEP § 2111.01.I and 2111.01.III). An explicit and clear definition must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example. An applicant may define specific terms used to describe the invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "'set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the art notice of the change" in meaning (MPEP § 2111.01.IV and 2173.05(a)).

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4. The invention claims a **“computer server”**. (independent method claim 82, 94, 97 and 109). In general, a “server” in a computer context can be hardware or software. The specification discloses only a “server device” (p. 4 line 25), a “computer server” (p. 5 line 20) and “a server device 120” (p. 8 line 29 and Fig. 2). The specification does not disclose or suggest that a “server” should be interpreted as software. Hence, the claimed “computer server” is interpreted to be a machine or apparatus.
5. An **“information site”** is interpreted to be a website, which is widely understood to be is a collection of related web pages, images, videos or other digital assets that are addressed relative to a common Uniform Resource Locator (URL).
6. **“derives contextual information from said request”** (claims 74, 89, 104 and 119) is interpreted to be merely information derived from said request, i.e., the claimed phrase is a tautology. **“a site having a contextual relationship to information requested”** (claims 81, 96, 111 and 126) is interpreted to be a site that is relevant to the information requested.
7. **“determines/determining a geographic region for relevant information/said information request”** is interpreted to mean that the instant invention “derives geographic information from said request message” (claim 128).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 67-130 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
 - (A) At numerous claims including claim 67, lines 9-10, “information unresponsive to said information request” is new matter.
 - (B) At numerous claims including claim 67, lines 9-10, “third party” is new matter.

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(C) At numerous claims including claim 67, lines 11-12, "a second information site" is new matter.

(D) At numerous claims including claim 67, line 6, "**determines/determining a geographic region for relevant information/said information request**" is new matter.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 67-130 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) At numerous claims including claim 67, lines 9-10, "information unresponsive to said information request" is indefinite.

(B) At numerous claims including claim 67, lines 9-10, "third party" is indefinite. The plain meaning of "third party" is a business entity that is independent of some other first and second parties. However, business independence, which means independent ownership, is inherently indefinite because ownership distinctions are neither stable nor predictable. The US Supreme Court has ruled that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). A business entity can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership language cannot impart patentability.

(C) At claim 82, line 1, "said network" lacks antecedent basis.

(D) At claims 71, 86, 101 and 116, "determines information at said first information site" is indefinite. An "information site" is interpreted to be a website, which is merely a collection of displayable information for display (para. 5 above), which cannot "determine" anything. If applicant means that the determination is done at (within) the site's server, it needs to be claimed.

(E) At claims 73, 88, 103 and 118, "said geographic location ... and said geographic information ... are different" is indefinite. "location" and "information" are inherently different

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(see any dictionary). Assuming the applicant means that “said geographic location” is different from the location indicated by “said geographic information”, then the question is, how different? What criteria are used to determine “different”?

(F) At claims 81, 96, 111 and 126, **a site having a contextual relationship to information requested** is indefinite because there are no objective criteria disclosed for determining how a site is relevant to the information requested (para. 6 above).

(G) At numerous claims including claim 67, line 6, **“determines/determining a geographic region for relevant information/said information request”** is indefinite.

Claim Rejections - 35 USC § 102 and 35 USC § 103

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

(A) “[third party] information responsive/unresponsive to said information request” (e.g., at claims 67, lines 9-10). Entities, such as a “third party”, are not functional because they do not alter how the process steps are to be performed to achieve the utility of the invention. Similarly, whether the information is responsive or not does not alter how the process steps are to be performed to achieve the utility of the invention. In either case, the information is delivered, so “responsive” and “unresponsive” are merely words without functional meaning.

(B) “operated on behalf of a third party” (e.g., at claims 67, line 12, with reference to “a second information site”). The operator of a website is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

(C) “exclusive third party information provider” (e.g., at claims 75-78). Contract terms such as “exclusive” are not functional because they do not alter how the process steps are to be performed to achieve the utility of the invention.

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14. Claims 67-130 are rejected under 35 U.S.C. 102(b) as being anticipated by Riedman (1998 article in *Advertising Age*).

15. In summary, Riedman teaches a general purpose search engine reading on all the claim limitations explicitly or inherently. In particular, Riedman teaches (independent claims 67, 82, 97, 112, 79, 94, 109, 124 and 127-130) a computer readable storage medium, computer server and method of electronically providing information to a communication device, the method (as represented by claim 112) comprising the steps of:

(a) receiving at a first information site (*Goto.com*, first line of p. 2) hosted by a computer on a network an information request (inherently from *search results* at line 2) from said communication device communicating through said network;

(c) directing said computer to retrieve answer information (*search results*) from a database, said answer information comprising information responsive to said information request and information containing a link (inherently from *pay per click*) for use by said communication device to connect said communication device to a second information site operated on behalf of said third party; and

(d) directing said computer to provide said answer information (*search results*) from said first information site to said communication device.

16. Riedman does not explicitly teach,

“(b) directing said computer to determine a geographic area for relevant information to be provided in answering said information request”.

However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the purpose and function of a search engine is to provide relevant information in answering said information request. When the information request includes information identifying “a geographic area”, the reference invention will necessarily derives geographic information from said request message, which reads on the claim limitation (para. 7 above).

17. For claims 127 and 129, *pay per click* reads on an option to purchase a link.

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18. Riedman also teaches claims 70-72, 74, 78, 85-87, 89, 93, 100-102, 104, 108, 115-117, 119, 123, 80, 81, 95, 96, 110, 111, 125 and 126. For claims 78, 93, 108 and 123, a *real-time auction ad module* (line 1) reads on “periodically auctioning a right”.
19. The following claims add only non-functional descriptive material and were given no patentable weight: 68, 69, 73, 75-77, 83, 84, 88, 90-92, 98, 99, 103, 105-107, 113, 114, 118 and 120-122.

Response to Arguments

20. Applicant's arguments filed with an amendment on 5 May 2009 have been fully considered but they are moot in view of the new basis of rejection. Concerning the supplemental amendment, the “contextual relationship” material that applicant proposed to move from claims 81, 96, 111 and 126 to the parent claims is general and ill-defined; it would be of no value to patentability (para. 6 above). The other proposed changes to the claims rely on non-functional descriptive material, which would also not be helpful to patentability (para. 14 above).

Search for Allowable Matter

21. The examiner has searched this application for potentially allowable matter and regrets to report that none was found. The arguments filed on 6 April 2010 made of record that the examiner has suggested otherwise off the record, and that is true. But, that suggestion was based on the examiner's misunderstanding of the specification. The examiner's review of the record suggests that the application as filed simply does not disclose material that is patentable.
22. If applicant believes the claimed invention is patentable, an appeal to the BPAI would be appropriate. The examiner suggests applicant first file arguments after final under 37 CFR 1.116 to explain where support is found for the material rejected as new matter and indefinite (para. 9 and 11 above).

Conclusion

23. The references made of record and not relied upon are considered pertinent to applicant's disclosure. *PC Magazine Online* also reads on the claimed invention, and is notable for its

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evaluation of the Google search engine in early 1999 as, "the site has an uncanny knack for returning extremely relevant results". Sullivan is notable for its discussion of the earlier GoTo.com introduction of "paid listings" (as disclosed by Riedman) and relevance of search results.

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
27. The examiner's supervisor, Lynda Jasmin, can be reached on 571-272-6782.
28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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29. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. **The examiner will grant an interview after final only when applicant files an interview request (form PTOL-413A)** containing compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
30. Applicant may have after final arguments considered and amendments entered by filing an RCE.
31. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

10 April 2010

/Donald L. Champagne/
Primary Examiner, Art Unit 3688